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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,664	03/11/2004	Roland Ellwood Dolle	ADOL-0712	6307

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EXAMINER

SEAMAN, D MARGARET M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,664

Applicant(s)

DOLLE ET AL

Examiner

D. Margaret Seaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 and 77-93 is/are pending in the application.
- 4a) Of the above claim(s) 33-44, 48-53 and 77-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 14-26 and 45-47 is/are rejected.
- 7) ☒ Claim(s) 10-13 and 27-32 is/are objected to.
- 8) ☒ Claim(s) 1-59 and 77-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application was filed 3-11-2004. Claims 60-76 have been canceled by paper dated 5/2/2005. Claims 1-59 and 77-93 are before the Examiner.

Election/Restrictions

1. Applicant's election with traverse of Group I (claims 17-32 and 46 (in full) and claims 1-16, 45 and 47 (in part)) in the reply filed on 5/2/2005 is acknowledged. (Claims 33-35 are drawn to compounds of formula IV and have been moved to group II.) The traversal is on the ground(s) that (1) the search and examination of the entire application can be made without serious burden and (2) that it is incumbent upon the office to conduct a search of all of the claimed subject matter. This is not found persuasive because (1) the search for the entire application would be a serious burden upon the examiner and (2) the office searches one invention. As for group IV, this group is not limited to the compounds of group I, it contains further active ingredients not part of claim 1. As for groups V-XI, as per Ochiai, if/when the compound claims become allowable, the methods of use claims will be rejoined. However, if those claims are not found allowable, then the action could be made final.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 33-44, 48-59 and new claims 77-93 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention,

there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/2/2005.

3. This application contains claims 33-44, 48-59 and new claims 77-93 drawn to an invention nonelected with traverse in Paper dated 5/2/2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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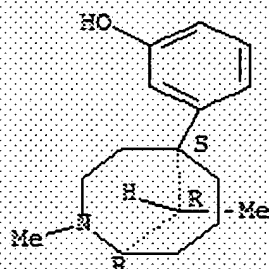
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or, on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 14-23 and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobson (CA 125:185591) and Aceto (CA 1235:185593).

Jacobson and Aceto teach

RN 88550-29-2 CA
CN Phenol, 3-(2,9-dimethyl-2-azabicyclo[3.3.1]non-5-yl)-, anti- (9CI)
INDEX NAME)

Relative stereochemistry.



as a

pharmaceutical.

6. Claims 1-9, 14-26, 28 and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (Tetrahedron Letters and J Med Chem). Thomas teaches formula 3 in Tetrahedron Letters and formula 5c in J Med Chem as pharmaceutical compounds that anticipate the instant claims.

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7. Claims 1-9, 14-26 and 45-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Carroll (US Patent #6531481). Carroll teaches the instantly claimed compounds in claims 1-9.


Claim Objections

8. Claims 10-13 and 27-32 are free of prior art and are objected to as being dependent from a rejected base claim.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 630am-4pm, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. Margaret Seaman
Primary Examiner
Art Unit 1625

dms